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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77945451
Applicant	Mirabella Beauty Products, LLC
Applied for Mark	MIRABELLA
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Submission	Appeal Brief
Attachments	MIRABELLA (Serial No. 77945451) -- Appeal Brief.pdf (6 pages)(25254 bytes)
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Date	05/02/2012

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In re Mirabella Beauty Products, LLC)
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Attorney's Reference: 121186-309019

Mark: **MIRABELLA**
Application Serial No. 77/945,451
Examining Attorney: James W. Ringle, Esq.
Law Office 111

Applicant's Appeal Brief

I. Issue on Appeal

Applicant seeks to register the mark **MIRABELLA** for “make-up and cosmetics, namely, foundation, pressed powder, loose powder, face powder, powder blush, concealer, mascara, eye liner, eye shadow, lash primer, eye make-up remover, lipstick, lip liner, and lip gloss” in International Class 3. The Examining Attorney has refused registration several times (see below) on the ground that the mark is allegedly “primarily merely a surname” within the meaning of Section 2(e)(4) of the Trademark Act. This is the sole issue on appeal.

II. Relevant Prosecution History

On June 1, 2010, the Examining Attorney issued an Office Action refusing registration on the ground that Applicant's mark **MIRABELLA** is primarily merely a surname. As evidence, the Examining Attorney attached a printout from the website www.whitepages.com that, he contended, showed Mirabella “appearing more than 100 times as a surname in a nationwide telephone directory of

names.” This was the only evidence attached to the Office Action. The Examining Attorney suggested that Applicant amend the application to the Supplemental Register.

On March 4, 2011, Applicant’s prior counsel filed a response (and a petition to revive) that asserted acquired distinctiveness under Section 2(f) on the ground that the mark had purportedly been in use for “at least the five years immediately before the date of this statement,” but included dates of use that pre-dated that statement by only about 16 months (November 1, 2009 to March 4, 2011).

On March 7, 2011, the Examining Attorney issued a second Office Action that not surprisingly refused to accept the Section 2(f) claim, pointing out the discrepancy between the claim of five years’ use and the actual dates of use claimed. The Examining Attorney again suggested that Applicant amend the application to the Supplemental Register .

On September 7, 2011, Applicant filed a Power of Attorney appointing its present counsel. That same day, Applicant filed a response to the outstanding Office Action that (1) withdrew the Section 2(f) claim made by prior counsel, and (2) submitted arguments as to why Applicant’s mark **MIRABELLA** is not primarily merely a surname. In that response, Applicant pointed out that the evidence attached to the Examining Attorney’s first Office Action did not, in fact, show that Mirabella appeared “more than 100 times” as a surname (it made no reference at all to any number). Applicant also introduced its own evidence from www.whitepages.com showing that there are only 98 people in the entire United States with the surname Mirabella. Applicant also made of record a printout from the website RhymeZone that described Mirabella as a “very rare” surname, with a popularity rank of 25,303.

On September 29, 2011, the Examining Attorney issued a third Office Action that (implicitly) maintained the surname refusal, stated that the mark appears to mean “beautiful sight,” and suggested amending the application to provide a translation statement to that effect “as a means of overcoming

the refusal.” This Office Action did not actually require a translation statement from Applicant, nor did it address any of Applicant’s arguments against the surname refusal.¹

On February 1, 2012, Applicant submitted a response advising the Examining Attorney that the mark “has no exact translation.”

On February 23, 2012, the Examining Attorney issued a fourth non-final Office Action indicating that the surname refusal was maintained. The Examining Attorney again did not address any of Applicant’s arguments. Instead, the Examining Attorney suggested, for the third time, that Applicant amend the application to the Supplemental Register. This appears to have been the sole purpose of this Office Action.

Applicant then filed a notice of appeal with the Board pursuant to Trademark Rule 2.141(a), which provides that “[a] second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.”

III. Evidence of Record

The only evidence made of record by the Examining Attorney is the printout from www.whitepages.com attached to the first Office Action. Applicant made of record a printout from that same website showing there are 98 people in the United States with the surname Mirabella, and evidence from RhymeZone stating that Mirabella is a “very rare” surname.

IV. Argument

¹ See T.M.E.P. § 713.03 (“When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney must respond to the applicant’s arguments.”).

Given that the Examining Attorney has neither made any effort to address Applicant's arguments nor made any serious attempt to introduce evidence to support the refusal, Applicant will simply reiterate the arguments it submitted during prosecution.

Putting aside the stylization in Applicant's mark **MIRABELLA**, there are only 98 people in the entire country with the surname Mirabella, which makes it an extremely rare surname. On this point, in recent years the Board has placed great weight on the rareness factor. For example, in reversing a surname refusal of BAIK, the Board remarked that "Baik is an extremely rare surname. In concluding so, we rely on the fact that only 456 examples of the Baik surname were located from a comprehensive directory of the entire United States." *In re Joint-Stock Company "Baik"*, 84 U.S.P.Q.2d 1921, 1923 (T.T.A.B. 2007).

In 2009 the Board reversed a surname refusal of BERGFELD for wine, explaining that it was giving the rareness factor "much more weight than the other three factors":

We find, based on the evidence, that BERGFELD is an extremely rare surname. Although the examining attorney submitted evidence showing use of the surname "Bergfeld" in commerce by different individuals, she was only able to produce evidence indicating there are fewer than 300 individuals with that surname after searching two comprehensive databases.

(. . .)

In balancing the aforementioned factors, we make no secret that the first factor, rareness of the surname, has been given much more weight than the other three factors. And, in doing so, we find that any slight tilt toward finding the mark as being primarily a surname based on the other factors is outweighed by the fact that there are fewer than 300 persons with the surname "Bergfeld." Ultimately, we conclude that applicant's proposed mark, BERGFELD, is so rarely used as a surname, and that the remaining *Benthin* factors provide little additional support for a finding that it would be so perceived by consumers, that it is not primarily merely a surname.

In re Hall Wines, LLC, Serial No. 78926151 (T.T.A.B. February 10, 2009) (non-precedential) (bolding added).

Likewise, in a 2008 decision involving approximately 150 surname listings, the Board found the applied-for mark AMLIN to be “an *extremely* rare surname” and reversed the refusal:

Applicant argues that “Amlin” is an *extremely* rare surname while the Trademark Examining Attorney contends that it is a *relatively* rare surname. Eliminating the unavoidable duplication in the databases and choosing a midrange of one-hundred-fifty separate listings in the entire United States, we are looking at a surname for only one in every two million individuals in the U.S. population. Hence, we agree with applicant that “Amlin” is such an *extremely* rare surname that few prospective consumers are likely to perceive it as a surname, and substantially no one will be adversely affected by the registration of this term for the recited services.

In re Amlin plc, Serial No. 79011475 (T.T.A.B. September 30, 2008) (non-precedential).

Even more so than BERGFELD (~300 individuals) and AMLIN (~150 individuals), Mirabella, with only 98 people in the entire country having this surname, is an extremely rare surname such that virtually no one will perceive it as a surname or be adversely affected by its registration. “[T]he word ‘primarily’ was added to ‘merely’ with the clear ‘intent . . . to draft a provision which would prevent a refusal to register only because a surname was found in a directory to be the name of somebody somewhere.’” *In re Garan Inc.*, 3 U.S.P.Q.2d 1537, 1539 (T.T.A.B. 1987) (quoting *Ex Parte Rivera Watch Corp.*, 106 U.S.P.Q. 145, 149 (Comm’r Pats. 1955)). For the foregoing reasons, Applicant respectfully submits that its mark MIRABELLA is not “primarily merely a surname.”

V. Conclusion

Because Applicant’s mark MIRABELLA is not primarily merely a surname, Applicant respectfully requests that the refusal be reversed.

Respectfully submitted,

Date: May 2, 2012

/Michael E. Hall/

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